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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 81230.87US2

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]	Application Number 10/749,089	Filed 12/30/2003
on ___July 27, 2007___ Signature _____	First Named Inventor Mauro Dresti	
Typed or printed name ___Sheri Fassl___	Art Unit 2623	Examiner Huynh, Son P.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.
x

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.
x

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,906

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Gary R. Jarosik
Typed or printed name

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Telephone number

July 27, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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REQUEST FOR PRE-APPEAL REVIEW

In the application claims 21-31 remain pending and stand finally rejected under 35 U.S.C. § 103 as allegedly being rendered obvious by the combination of Ellis (U.S. Published Application No. 2005/0028208) and Baker (U.S. 6,597,374).

The claimed invention is directed to a remote control having a memory in which is stored a library of command codes for use in directly commanding operations of a plurality of appliances, such as televisions, cable boxes, etc., i.e., a remote control of the "universal type." This claimed remote control is further provided with the ability to display a favorites page which includes a plurality of icons each of which is associated with a channel that is tunable to by at least one of the plurality of appliances. For example, Figs. 7 and 8 of the subject application illustrate a displayed favorites page having icons that are associated with channels such as "ABC," "HBO," etc. which channels are tunable to by means of an appliance that, in turn, is directly controllable through use of the claimed remote control. To setup the remote control whereby it may be used to cause a desired or appropriate one of the plurality of appliances to tune to a channel that is associated with an icon of the favorites page, the claims further call for the icons of the favorites page to be assigned at least one command code from the library of command codes resident within the memory of the remote control. The assigned at least one command code will thus cause an intended one of the plurality of appliances to tune to the channel that is associated with its respective icon when transmitted from the remote control directly to the appliance (e.g., an icon may be assigned one or more command codes recognizable by the television as a directive to tune to channel 7 on which "ABC" is broadcast, another icon may be assigned one or more command codes recognizable by the cable box as a directive to tune to channel 120 on which "HBO" is broadcast, etc.) . As further set forth within

the claims, the remote control will respond to a user selecting an icon within a favorites page displayed on the remote control by further displaying on the remote control information that is relevant to the channel associated with the selected icon (e.g., the remote control may display "HBO" programming information in response to the icon that is associated with the "HBO" channel being selected).

In rejecting the claims, it was asserted that, among other things, Ellis "inherently" discloses assigning to each of the icons of a favorites page displayed in a display of a remote control device an appropriate command code from a library of command codes stored within a memory of the remote control device to thereby allow for the tuning of an intended target one of a plurality of appliances to a channel associated with a selected one of the icons of the favorites page (*see* bottom of pg. 6, rejection of July 20, 2007).

In response, it is respectfully submitted that, to be inherently described in a reference the reference "must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill," i.e., inherency "may not be established by probabilities or possibilities" and the mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991).
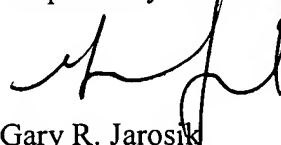
Turning now to Ellis, it is respectfully submitted that Ellis describes a system in which a local interactive television program guide is provided for each home appliance and a system in which it is *the local interactive television program guide* that is used to set reminders, control appliance program recording, control appliance channel tuning, etc. Ellis further describes that these *functions of the local interactive television program guide* may be remotely accessed using a remote access device 24 (*see* Fig. 12, Figs. 13a-13e - each setting forth "remotely access

functions of the local program guide over the remote access link..." as well as Fig. 14 and paras.

0137 and 0145+). Thus, it is respectfully submitted that it is clear that, within Ellis, the relevant

programming of the remote access device 24 is used <u>only</u> to access functions provided by a local

interactive television program guide and it is the local interactive television program guide that,

in fact, commands appliance functions such as VCR recording control and/or channel tuning.

(*see* paras. 0081, 0137, and 0138, and Fig. 19). Since the relevant programming of the remote

access device 24 of Ellis is used only to access functions that are provided by a local interactive

television program guide and since it is the local interactive television program that actually

performs the functions - whether it be to program a VCR, tune a channel, etc. - it will be

understood that the relevant programming of the remote access device 24 of Ellis <u>is itself</u>

<u>incapable of directly commanding any functions</u> of an appliance, i.e., without the local

interactive television program guide being a part of the system the remote access device 24 of

Ellis is simply incapable of controlling any appliance. For at least this reason, it is respectfully

submitted that, to the extent it was asserted within the Office Action that "a library of command

codes for use in commanding operations of a plurality of appliances must be stored in the

memory of the remote access device 24" (*see* bottom of pg. 5, rejection of July 20, 2007), it is

respectfully submitted that the memory of the remote access device 24 of Ellis need not store

commands for commanding operations of a plurality of appliances but, to the contrary, need only

store the data necessary to inform a local interactive television program guide which button a

user selected to thereby allow the local interactive television program guide to perform a

corresponding action. (*see* paras. 0137 and 0096+).

From the foregoing it is respectfully submitted that it is evident that Ellis cannot be said

to expressly or inherently disclose, teach, or suggest those claim elements that the rejection of

the claims has asserted may be found within Ellis. More particularly, it is respectfully submitted that, when Ellis is fully and fairly considered in its entirety as is required, it simply cannot be said that the system disclosed within Ellis <u>necessarily</u> allows for assigning to each of the plurality of icons of a favorites page displayed in a remote control at least one command code *from a library of command codes for use in directly commanding operations of a plurality of appliances stored within a memory of a remote control device* wherein *the assigned at least one command code is appropriate for causing an intended recipient one of the plurality of appliances to tune to a channel* associated with each of the plurality of icons when the at least one command code is transmitted from the remote control device *to the intended recipient one of the plurality of appliances* as is required of "inherency." Since it has not been asserted that Baker discloses these claimed elements that are clearly missing from Ellis, which Baker does not, and since any proposed modification of Ellis that would remove the functionality provided by the local interactive television program guide of Ellis, which is the core element of the system of Ellis, would impermissibly change the principle by which the system of Ellis operates (*see* MPEP § 2143.01IV) it is respectfully submitted that the combination of Ellis and Baker cannot support a *prima facie* case of obviousness under 35 U.S.C. § 103 and must be withdrawn.

Respectfully Submitted;

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